

### **REMARKS**

This communication responds to the *Office Action* dated November 4, 2009. Claims 12, 13, 18, and 19 are amended, no claims are canceled, and no claims are added. Consequently, claims 1-31, 33, and 34 remain pending in this application. Applicant avers that the amendments are supported by, at least, the Specification at [0029].

#### **§ 103 Rejection of the Claims**

Claims 1-31, 33, and 34 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Cheok* (U.S. Patent No. 6,934,906) in view of *Shahine* (U.S. Patent No. 7,082,576). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The recent U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

A rationale to support a conclusion that a claim would have been obvious is that ***all the claimed elements were known in the prior art*** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007))(Emphasis added).

*Cheok* and *Shahine* fail to disclose all the claimed elements of independent claims 1, 12, 20, and 27 for at least the following reasons.

I. Presentation description comprising a set of instructions that define a manner

Claim 1 recites, in part, “the manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system.” In context, claim 1 recites that the manner is defined by a “presentation description comprising a set of instructions that define a manner in which a portion of said first image and a portion of said second image may be combined.” The Examiner acknowledged that “*Cheok* does not further explicitly teach that the selected manner is chosen

based on user preference information in the system.” *Office Action* at 5. However, the Examiner alleged that *Shahine* discloses this feature because:

*Shahine* teaches a device for composing a displayed scene using a presentation description to arrange data objects (Abstract), wherein the arranged objects include images (col. 13, l. 20-29), in a plurality of manners based on a priority associated with the object (Abstract), wherein the priority is determined based on user preference information stored in the device (col. 8, l. 21-35). *Office Action* at 5.

*Shahine* describes methods and systems “to display a summary of available information based on a predefined priority associated with each portion or element of that information.” *Shahine* at Abstract. In relevant part, *Shahine* recites that “a user may view the priority list, and assign desired priorities to each data object, or change existing priorities, whether predetermined, or previously set by the user.” Col. 8, lines 29-31. “Once priorities have been associated with data objects, ... the display manager module 420 then sorts the data objects in order of priority” (col. 9, lines 15-18) and “the display device 430 [is populated] with as many of the data objects as will fit... .” (col. 9, lines 36-38). It follows then that depending on the display area, the priorities associated with the data objects define exactly how the data objects are sorted and, consequently, displayed. Thus, instead of having “said **presentation description comprising a set of instructions that define a manner** in which a portion of said first image and a portion of said second image may be combined, the manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system,” *Shahine* provides that the user defines the alleged manner in which the images are combined. This is fundamentally different than claim 1. Therefore, *Shahine* too fails to disclose this feature of claim 1.

## II. Receiving Second Video Signal

Claim 1 recites, in part, a “second video signal.” In the *Office Action*, the Examiner cited to operation 403 of FIG. 4, which describes “obtain[ing] second information including a second part of a BIFS scene description stream that contains a reference to an external application,” as

disclosing this feature of claim 1. *Office Action* at 4. Operation 403 fails to disclose this feature of claim 1 for any of the reasons described below.

First, operation 403 of *Cheok* merely obtains the “second part of a BIFS scene description stream.” See, *Cheok* at FIG. 4. The first part of the BIFS scene description stream is obtained at operation 401, which the Examiner relies on to allege the first video signal of claim 1. *Office Action* at 3. However, *Cheok* fails to disclose that a BIFS scene description stream is obtained over multiple video signals. Thus, because the second part of the BIFS scene description stream is a continuation of the first part of the BIFS scene description stream, the first and second parts of the BIFS scene description stream are transmitted, at most, over a single signal. Thus, even assuming, *arguendo*, that the BIFS scene description is sent over a video signal, *Cheok* at most discloses transmitting the BIFS scene description over a single video signal and, as a result, cannot form the basis of the disclosure for “a second video signal,” as recited by claim 1.

Second, the Examiner mischaracterized *Cheok* and the “video signal” feature of claim 1 by rejecting the “first” and “second video signal” under the basis that “information may be an image.” *Office Action* at 3 (citing *Cheok*, col. 3, line 56). A closer reading of the portion of *Cheok* cited by the Examiner merely recites that “MPEG-4 native objects may be anything defined by an MPEG-4 node, such as for example a graphical object or a textual object.” Col. 3, line 55-57. An MPEG-4 native object in no way discloses a “video signal,” as recited by claim 1. In particular, the MPEG-4 is a “standard[] for *coding* of audiovisual information.” Col.1, line 51 (emphasis added). Since coding says nothing about a signal, *Cheok* fails to disclose a “second video signal.”

Independent claims 12, 20 and 27 recite similar language. In particular, these claims recite “a second video signal.” Therefore, for the reasons described above, *Cheok* fails to disclose these features of claims 20 and 27.

With respect to *Shahine*, the addition of *Shahine* does not cure the deficiencies of *Cheok* with respect to claims 1, 20, and 27. In particular, *Shahine* fails to even suggest receiving a first and second video signal, as recited by claims 1, 20, and 27. Therefore, *Shahine* similarly fails to disclose the above features of these claims.

### III. Claims 12 and 18

Although the Applicants believe that the original pending claims define over the art of record, the Applicants have amended independent claim 12 to further clarify, in part:

***[R]eceiving a plurality of presentation descriptions*** in said system, the plurality of presentation descriptions each comprising a set of instructions that define a manner in which a portion of said first sequence of images and a portion of said second sequence of images may be combined, and ***the plurality of presentation descriptions each comprising an identifier;***

***selecting one of the plurality of presentation descriptions*** to define the manner in which the sequences of images are combined ***based on a selected identifier, the selected identifier being based upon user preference information in said system,*** and the selected presentation description instructions also defining a sequence of operations performed over time;

combining said portion of said first sequence of images with said portion of said second sequence of images ***in accordance with the selected presentation description*** to produce a finalized sequence of combined images.

For at least some of the reasons described above, *Cheok* and *Shahine*, singly or in combination, fail to disclose the above features of claim 12. As described above, *Shahine* discloses that a user defines exactly how the data objects are sorted and, consequently, displayed by “configuring” a “priority list.” *Shahine* at Col. 8, lines 27-31. However, a user configuring a priority list in no way discloses this feature of claim 12. Configuring implies editing or modifying an existing item, not “selecting ... based on a selected identifier, the selected identifier being based upon user preference information in said system,” as recited by claim 12. Still further, *Shahine* is completely silent as to “receiving a plurality of presentation descriptions, ... the plurality of presentation descriptions each comprising an identifier.”

Claim 18 depends directly on claim 12. Therefore, dependent claim 18 is allowable for at least the same reasons. Further, claim 18 recites “the selected identifier being based also on

demographics of the viewer.” Since neither *Cheok* nor *Shahine* disclose the “selected identifier,” these references also fail to disclose “the selected identifier also being based on demographics of the viewer.” Moreover, *Cheok* and *Shahine* are completely silent as to “demographics” in general, much less a “selected identifier being based also on demographics of the viewer.”

Since Applicant has shown that not all the claimed elements were known as required by *KSR*, by *Cheok* and *Shahine* singly or in combination, the Applicants respectfully request the Examiner to withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 12, 20, and 27. Further, the corresponding dependent claims too are allowable for at least the same reasons. Furthermore, these dependent claims each may contain additional patentable subject matter.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned at (408) 278-4057 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402--0938  
(408) 278-4057

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By / Susan Yee /  
Susan Yee  
Reg. No. 41,388

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 4<sup>th</sup> day of February, 2009.

John D. Gustav-Wrathall  
Name

/ John D. Gustav-Wrathall /  
Signature